

No. 10-545

In the Supreme Court of the United States

LAWRENCE GOLAN, ET AL.

Petitioners

v.

ERIC H. HOLDER, JR., ATTORNEY GENERAL, ET AL.

Respondents

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

**BRIEF OF H. TOMAS GOMEZ-AROSTEGUI
AND TYLER T. OCHOA AS *AMICI CURIAE* IN
SUPPORT OF PETITIONERS**

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INTEREST OF *AMICI CURIAE*¹

This brief *amicus curiae* is submitted in support of petitioners by H. Tomas Gomez-Arostegui and Tyler T. Ochoa pursuant to Rule 37 of the Rules of this Court.

Amici are scholars who have studied the history and development of copyright laws in Great Britain and the United States. *Amici* are interested in assuring that Congressional enactments, including Section 514 of the Uruguay Round Agreements Act (URAA), are consistent with, rather than in conflict with, that history. To that end, *amici* present a summary of their understanding of the relevant history to aid the Court in its deliberations.

SUMMARY OF ARGUMENT

This case concerns Section 514 of the Uruguay Round Agreements Act of 1994, Pub. L. No. 103-465, 108 Stat. 4976. That section restored copyright protection to certain foreign works that had entered the public domain. The questions presented are whether Section 514 violates the Copyright Clause or the First Amendment of the Constitution. Both inquiries depend, in large part, on the history of Anglo-American copyright law, particularly as it

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1. No counsel for a party authored this brief in whole or in part, and no person other than *amici* made a monetary contribution to the preparation or submission of this brief. The parties have consented to the filing of this brief by submitting blanket consents to the Court.

existed just before the enactment of the Copyright Act of 1790. See Act of May 31, 1790, 1 Stat. 124.

The chief issue this brief addresses is whether, in enacting the 1790 Act, the First Congress restored works from the public domain, thereby creating a First Congress precedent for the URAA. The parties and the lower courts disagree on this point. This brief discusses the historical record and concludes that the record does *not* support the view that the First Congress believed it was removing works from the public domain. If anything, it is more likely that members of the First Congress believed that they were limiting and preempting preexisting copyrights based on the common law.

ARGUMENT

I. The Doctrinal Relevance of Anglo-American Copyright Law circa 1790

This Court has stated that when it evaluates whether a statute violates the Constitution, it will be predisposed to find the statute constitutional if the First Congress, which met from 1789 to 1791, enacted similar legislation. *Myers v. United States*, 272 U.S. 52, 175 (1926).² Many members of the First Congress were delegates to the Constitutional Convention, and it was the First Congress that proposed the Bill of Rights. Accordingly, this Court has

2. Of course, not every statute enacted by the First Congress was constitutional. See *Marbury v. Madison*, 5 U.S. (1 Cranch) 137 (1803) (holding a portion of § 13 of the Judiciary Act of 1789 was unconstitutional).

spoken of the importance of examining the Copyright Act of 1790 when analyzing constitutional challenges to our copyright laws. *Eldred v. Ashcroft*, 537 U.S. 186, 213, 219 (2003); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57 (1884).

Following that lead, the Tenth Circuit and the D.C. Circuit consulted the 1790 Act in deciding the questions presented here. *Golan v. Gonzales*, 501 F.3d 1179, 1190–91 (CA10 2007) (Copyright Clause and First Amendment) (*Golan I*); *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1265 (CA10 2005) (Copyright Clause). Both courts queried whether the First Congress had granted copyright protection to works already in the public domain, thereby creating a precedent for restoration under the URAA. *Golan II*, 501 F.3d at 1190–91; *Luck’s Music*, 407 F.3d at 1265. Specifically, they investigated whether previously published works were protected before the 1790 Act, particularly as a matter of state common law.³

The two courts reached different conclusions. The Tenth Circuit thought the historical record was too barren to support any definitive conclusions, despite the fact the petitioners had “argued convincingly that most, if not all, . . . works were covered by a *state* common-law copyright and therefore not in the public domain.” *Golan II*, 501 F.3d at 1191. The court thus refused to conclude that the First

3. Both parties agree that, before 1790, state common law protected works that were composed but unpublished.

Congress “thought it was removing works from the public domain” when it enacted the 1790 Act. *Id.*

The D.C. Circuit was less circumspect. It acknowledged that the “historical evidence on this point [was] contested.” *Luck’s Music*, 407 F.3d at 1265. But it nevertheless held that the Court’s decision in *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), had already settled the issue. There, the Court held that a common-law right in published works had never existed as a matter of federal or Pennsylvania law. *Id.* at 659–661. By implication, the D.C. Circuit concluded that the First Congress must have known it was removing works from the public domain. *Luck’s Music*, 407 F.3d at 1265.

This *amicus* brief will demonstrate that the Tenth Circuit’s conclusion is the most sensible in light of the historical record. Although there are no American cases before 1790 recognizing a common-law right in published works, evidence indicates that many contemporaries believed that published works were protected by state common law, largely on the basis of arguments first espoused in English case law. Nevertheless, the historical record is fragmentary. As a consequence, the only definitive conclusion that one can draw is that the history does *not* demonstrate that the First Congress believed it was removing works from the public domain. If anything, the history suggests that the 1790 Act limited and harmonized protections that existed prior to its enactment. In short, there is no First Congress precedent for the URAA.

The relevant history begins with the British

experience with common-law copyright. Early American copyright law was greatly influenced by the law of Great Britain, and the very issue presented here—whether the first comprehensive copyright statutes removed works from the public domain—was answered in Great Britain in 1774. Additionally, new evidence in this area undercuts a key premise of this Court’s holding in *Wheaton*. We then examine the history of U.S. copyright law.

II. The British Experience

The Statute of Anne, 1710, 8 Anne, c. 19, was the first modern copyright statute. It was not the first system to regulate copyrights, however, nor was it the first statute to do so. Before 1710, there were several sources of exclusive printing rights. Notably, recent research has uncovered numerous lawsuits that were filed before 1710 in equity on the basis of a purported copyright at common law.

A. English Antecedents

The most established exclusive right to print was a royal privilege, which the Crown granted by letters patent or royal license to a publisher, printer, or author. Privileges covered single works or a whole class of works. Most grants were for a term of years or the life of the grantee, but due to renewals and reversions, many privileges were

effectively perpetual.⁴ The earliest record we have of an exclusive printing privilege is from circa 1512.

A second exclusive right stemmed from a royal charter granted in 1557 to the Company of Stationers, the guild governing printers, booksellers, and others in the book trade. Internal customs of the Company established a system whereby a copyright would inure to a member who entered a book's title in the Company's register book, so long as that book was not already protected by a privilege or prior registration. Generally speaking, only Company members could register works, but members could register works in trust for non-members and authors.⁵ Copyrights under this system were perpetual; that is to say, they never entered the public domain.

The registration system persisted under the auspices of several Star Chamber decrees from 1566 to 1641; parliamentary ordinances and statutes during the Civil War and Interregnum from 1643 to 1660; and then under the Printing Act of 1662 after the Restoration.⁶ The Printing Act lapsed between March 1679 and June 1685 and

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4. H. Tomas Gomez-Arostegui, *The Untold Story of the First Copyright Suit under the Statute of Anne in 1710*, 25 Berkeley Tech. L.J. 1247, 1250–56 (2010).
 5. *Id.* at 1254 nn.19 & 25.
 6. The government supported the registration system because it better enabled censorship. Before publication, all books printed in England had to be licensed by the censorship authorities and registered with the Company.

then expired permanently in May 1695.⁷ These two lapses of protection (1679–1685 and 1695–1710) constituted statutory copyright interregnums—a time when copyright was not supported by statute.

While supported by the laws noted above, members usually enforced their copyrights in the specialized Court of Assistants of the Company of Stationers. The Assistants served as the Company’s governing body and as a forum to mediate and arbitrate disputes among members. The court was also empowered to discover and seize illicit books and presses, which largely obviated the need for litigants to seek aid in the principal courts.⁸

But the statutory lapses robbed the Assistants of much of their power. So as early as 1681, copyright holders began filing copyright-infringement complaints in the Court of Chancery, seeking injunctive relief. Not supported by any statutory authority or privilege, these equity suits were typically brought under a purported copyright at common law.⁹

At least six such suits were filed from 1681 to 1685, during the first lapse of the Printing Act. The cases are unreported, but their records are located

7. H. Tomas Gomez-Arostegui, *What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-at-Law Requirement*, 81 S. Cal. L. Rev. 1197, 1216–18 (2008).

8. *Id.* at 1256–62.

9. Gomez-Arostegui, *supra* note 4, at 1255–56.

in the National Archives of the United Kingdom.¹⁰ None of these suits ended in a final decree—which was not unusual in copyright suits—but they suggest that copyright holders believed they held a copyright by custom or common law, and that at least some equity judges seemed inclined to agree.

In one case, for example, the Lord Chancellor granted an interlocutory injunction and ordered the defendants to deliver the allegedly infringing work to the author of the plaintiff's book, so the author could compare them and certify whether they were the same or not.¹¹ In another case, a plaintiff sued several booksellers for selling pirated books, seeking injunctive relief and discovery to support an action at law for damages. The court entered an interlocutory injunction,¹² and the defendants demurred on several grounds. Over the course of several hearings, the Lord Chancellor denied the demurrer and ordered the defendants to fully

10. See *Chiswell v. Lee*, C10/209/24 (Ch. 1681); *Pawlett v. Lee*, C10/202/96 (Ch. 1681); *Herringman v. Clerke*, C8/301/33 (Ch. 1681/2); *Pawlett v. Lee*, C10/211/60 (Ch. 1683/4); *Pawlett v. Lee*, C10/212/68 (Ch. 1683/4); *Pawlett v. Smith*, C10/218/34 (Ch. 1685).

References to C5, C6, C7, C8, and C10 represent Chancery pleadings in the National Archives. References to C33 represent orders and decrees from the Chancery's register books. All C33 orders referred to herein are imaged and transcribed at www.oldcopyrightcases.org.

11. *Chiswell v. Lee, sub nom. Chiswell v. Braddill*, C33/257, f. 100^r (Ch. 1681).

12. *Herringman v. Clerke*, C33/257, f. 216^v (Ch. 1681/2).

answer the plaintiff's complaint, with the exception that they would not have to identify their customers.¹³

Copyright holders returned again to the principal courts after the Printing Act expired in 1695. At least eleven lawsuits, all unreported, were filed in the Court of Chancery or the Court of Exchequer between 1695 and the enactment of the Statute of Anne.¹⁴ Two of the cases bear recounting in some detail because the defendants challenged the existence of common-law copyrights, but the Lord Chancellor appears to have rejected the defense.

In the first suit, filed in February 1709, the plaintiff claimed to own, by assignment, the copyright in a book first published in 1656. Lord Chancellor Cowper granted a temporary restraining order, summarizing the claim as follows:

[T]he plaintiff [alleges that he] is by purchase for a valuable consideration possessed of and (as he is advised) legally intitled unto the original Copy and Copy Right or the sole propriety of

13. *Id.* at C33/259, ff. 427^r, 278^v–279^r (Ch. 1682–83); see also Gomez-Arostegui, *supra* note 4, at 1308 n.326.

14. *E.g.*, *Brewster v. Newcombe*, C5/148/61 (Ch. 1697); *Ponder v. Braddyll*, C6/465/127 (Ch. 1697); *Pawlett v. Minshall*, C7/272/53 (Ch. 1701); *Keble v. Parker*, E112/836/804 (Exch. 1704/5); *Keble v. Onley*, E112/836/802 (Exch. 1705); *Tonson v. Hills*, C8/623/33 (Ch. 1706); *Rogers v. Hills*, C5/342/64 (Ch. 1708).

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When the defendant answered, he argued that the plaintiff could not have a copyright at common law, stating that a work could be protected by letters patent only. The case came before the Lord Chancellor again, on whether to convert the TRO into a preliminary injunction. Notably, the court ignored the defendant's argument and instead referred the case to a master to compare the books to determine if they were "one and the same Booke and whether they matterially differr or not."¹⁶ The defendant seems to have conceded soon afterward.

In the second suit, also filed in 1709, Lord Chancellor Cowper was again asked to rule on whether a copyright in published works existed as a matter of common law, this time on a demurrer.¹⁷ Although the demurrer was filed in January 1710, the Lord Chancellor did not hear it until May 1710, one month after the Statute of Anne was enacted. The defendant demurred at the hearing on three grounds: (1) he printed the books before the statute, which he was free to do because the plaintiff could have no copyright at common law; (2) even if the plaintiff did have such a right, the Chancery should not enforce a discovery to make

15. *Wellington v. Levi*, C33/312, f. 205^{r-v} (Ch. 1708/9).

16. *Id.* at C33/314, ff. 54^v–55^r (Ch. 1709).

17. *Horne v. Baker*, C5/290/70 (Ch. 1709); see also Gomez-Arostegui, *supra* note 4, at 1299–1309 (detailed account).

evidence; and (3) the Chancery had no power to award a disgorgement of the defendant's profits.¹⁸

The Lord Chancellor granted the demurrer, but a surviving manuscript report of the case indicates it was granted only on grounds (2) and (3).¹⁹ The report also indicates that, in so ruling, the court believed there was a common-law copyright in published works predating the Statute of Anne:

I am not willing to carry this matter so far, especially now the late act of parliament [the Statute of Anne] has given *another* remedy in respect of the property in Copies of Books.²⁰

Had the court believed the statute created a new right, one that had previously never existed before, the Lord Chancellor surely would have said something very different.

B. The Statute of Anne

Though the Stationers continued to comport themselves after 1695 as if their works remained protected in perpetuity by the common law, they also agitated for the previous laws to be revived and, failing in that task, lobbied for a new

18. Gomez-Arostegui, *supra* note 4, at 1306–07.

19. *Id.* at 1307–08.

20. *Id.* at 1307 (emphasis added), quoting *Horne v. Baker*, Lincoln's Inn Misc. MS 10, p. 1 (Ch. 1710).

copyright statute.²¹ In their view, they had common-law copyrights, but the legal remedy of damages was inadequate. They thus asked that the new statute revive the remedies they had under the Printing Act: fixed penalties and the confiscation of illicit books. Under their proposal, copyrights were also to remain perpetual.²²

Parliament was sympathetic to some of the booksellers' claims, and the Statute of Anne, which came into effect on April 10, 1710, included the remedies the Stationers had sought. Parliament, however, appeared to rebuff the requested perpetuity. Although it created a new statutory copyright for books first published after April 10, the statutory term was strictly limited to 14 years from first publication, with a possible reversion and additional term to the author of another 14 years if she was still living at the expiration of the first term.²³ A legacy clause protected previously published works for a period of only 21 years from the effective date of the statute.²⁴

Unfortunately, the Statute of Anne was hastily and poorly drafted, and thus left many questions unanswered. Chief among them was whether, by

21. Ronan Deazley, *On the Origin of the Right to Copy* 1–37 (2004).

22. Mark Rose, *Authors and Owners* 42–43 (1993).

23. Statute, 1710, 8 Anne, c. 19, § 1.

24. *Id.*

an ambiguous savings clause in the statute, Parliament meant to preserve common-law copyrights.²⁵

C. Statutory Copyright Prevails

After the legacy clause expired in 1731, and older works presumably began entering the public domain, the booksellers began, once again, to file suits based on a copyright at common law. As before 1710, they filed chiefly in the Court of Chancery, seeking injunctive relief and, in lieu of an ordinary damages remedy at law, a disgorgement of the infringer's profits.²⁶ These lawsuits nearly always ended after the court granted an interlocutory injunction, as the injunction was usually enough to satisfy the plaintiffs.

It was not until 1769 that a court reached a final decision on common-law copyrights. In *Millar v. Taylor*,²⁷ the King's Bench held, 3 to 1, that authors and their assigns had a perpetual common-law

25. *Id.* § 9 (“[N]othing in this Act contained shall extend or be construed to extend either to prejudice or confirme any right that . . . any person or persons have or claime to have to the printing or reprinting any booke or copy already printed or hereafter to be printed.”).

26. In 1737, the Chancery began awarding plaintiffs a disgorgement of the defendant's profits. The remedy could be awarded only if the court had also entered a final injunction. These twin remedies became the norm in copyright suits. H. Tomas Gomez-Arostegui, *Prospective Compensation in Lieu of a Final Injunction in Patent and Copyright Cases*, 78 Fordham L. Rev. 1661, 1702–03 (2010).

27. 4 Burr. 2303, 98 Eng. Rep. 201 (K.B. 1769).

copyright in published works. According to the court, the right predated the Statute of Anne, and the savings clause of the statute preserved the right. The court based its ruling in large part on the equity cases that had been filed after 1731 and based on a purported common-law right.²⁸

The House of Lords revisited the issue a few years later in *Donaldson v. Becket*.²⁹ The case began in the Court of Chancery, where the Lord Chancellor ruled in favor of a common-law right based on *Millar*. On appeal, the Lords rejected the idea of a perpetual copyright and held that copyright in published works in Great Britain was to be governed by statute only. Unfortunately, although the result in *Donaldson* was clear, the reasoning was not, largely because of the way Parliamentary cases were decided and reported.

At the time, the Lords decided appeals by a vote of the peers, lawyers and laymen alike.³⁰ Thus, the Lords often summoned the twelve common-law judges from the courts of England to advise how to rule on a matter. The Lords could accept or reject the recommendations of the judges, but rejections were exceedingly rare.

28. *Id.* at 2323, 2352–53, 2399–2400, 98 Eng. Rep. 212, 227–58, 253. The court was unaware of the numerous equity cases filed before 1710 and discussed *supra* pp. 7–11.

29. 4 Burr. 2408, 98 Eng. Rep. 257, 2 Bro. PC 129, 1 Eng. Rep. 837, 17 Cobb. Parl. Hist. 953 (H.L. 1774).

30. Rose, *supra* note 22, at 97.

Eleven of the judges spoke in *Donaldson*. The official tally of their views, which was reported in the Journals of the House of Lords and in James Burrow's published report of the case, indicates that the judges voted 7 to 4 that a common-law right in published works did exist before the Statute of Anne, but 6 to 5 that the statute preempted it.³¹ After debate, the Lords voted 21 to 11 to reverse the decree of the Chancery.³²

Most of the Lords did not state their reasons, thus leaving unexplained whether they had voted to reverse because there *never was* a copyright at common law in published works or because such a right *no longer existed* due to statutory preemption. The conventional wisdom, however, was that the Lords had adopted the latter view, following the recommendation of the majority of the judges, as reported by Burrow.³³ This remains the orthodox, and most widely accepted, reading of *Donaldson*.³⁴

31. 34 H.L. Jour. 23–24, 26–30, 32 (1774); accord *Donaldson*, 4 Burr. at 2417, 98 Eng. Rep. at 262.

32. *Donaldson*, 17 Cobb. Parl. Hist. at 1003.

33. *E.g.*, 1 Thomas W. Williams, *An Abridgment of Cases Argued and Determined in the Courts of Law* 117–19 (London 1798); Henry Lemoine, *Typographical Antiquities* 117 (London 1797).

34. Some historians now believe that one of the judge's votes was incorrectly recorded, and that the judges actually voted 6 to 5 *against* preemption. See Deazley, *supra* note 21, at 205; Rose, *supra* note 22, at 97–99; Howard B. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29

Most relevant for our purposes, the Statute of Anne did not restore copyright protection to works that were previously in the public domain. Literary works were protected before the statute as a matter of common law. The purpose of the statute was, instead, to limit the system of perpetual copyrights that predated it and, in effect, to create a public domain of works.

III. Copyright in Early America

The history of copyright in the United States bears many similarities to the history of copyright in England prior to the Revolution. In America, as in England, the existence of a perpetual common-law copyright after publication was a matter of vigorous debate; and in America, as in England, the term of copyright was ultimately limited by statute in order to create a public domain.

A. State Copyright Laws

In March 1783, in response to several authors' petitions, the Continental Congress appointed a committee "to consider the most proper means of

Wayne L. Rev. 1119, 1166–67 (1983); John F. Whicher, *The Ghost of Donaldson v. Beckett: An Inquiry into the Constitutional Distribution of Powers over the Law of Literary Property in the United States*, 9 Bull. Copyr. Soc'y USA 102, 130 (1961). These scholars all agree that this purported error allowed advocates of common-law copyright to claim that the peers had simply followed the majority of the judges—a fact these scholars allege was not true. These scholars disagree, however, on what other conclusions can be drawn from the revised vote count.

cherishing genius and useful arts through the United States by securing to the authors or publishers of new books their property in such works.”³⁵ In April, the committee reported that it was “persuaded that nothing is more properly a man’s own than the fruit of his study, and that the protection and security of literary property would greatly tend to encourage genius, to promote useful discoveries and to the general extension of arts and commerce.”³⁶ As a result, on May 2, 1783, the Continental Congress passed a resolution encouraging the states

to secure to the authors or publishers of any new books not hitherto printed . . . the copy right of such books for a certain time not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, . . . the copy right of such books for another term of time not less than fourteen years. . . .³⁷

Cf. *Sosa v. Alvarez-Machain*, 542 U.S. 692, 716–17, 721–22 (2004) (noting that a similar Congressional

35. 24 *Journals of the Continental Congress 1774–1789*, at 180 (1922).

36. *Id.* at 326.

37. Resolution of May 2, 1783, *Copyright Enactments of the United States 1783–1906*, at 11 (2d ed. 1906).

resolution in 1781, relating to the law of nations, presupposed preexisting common-law claims).

Three states had already enacted copyright statutes earlier that year; and within three years all of the remaining states except Delaware had followed suit.³⁸ “These statutes differed from each other in regard to many of the details, but they were all miniature versions of the Statute of Anne.”³⁹ See *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 648–50 (1943). Interestingly, the preambles of seven of the twelve statutes stated that copyright was a natural right of the author;⁴⁰ and three of the state statutes included a savings clause, modeled on the Statute of Anne, which specifically referred to the common law.⁴¹

38. *Id.* at 11–31.

39. Oren Bracha, *The Adventures of the Statute of Anne in a Land of Unlimited Possibilities: The Life of a Legal Transplant*, 25 Berkeley Tech. L.J. 1427, 1444 (2010).

40. See Act of Jan. 29, 1783 (Conn.); Act of Mar. 17, 1783 (Mass.); Act of Nov. 7, 1783 (N.H.); Act of Dec. 1783 (R.I.); Act of Nov. 18, 1785 (N.C.); Act of Feb. 3, 1786 (Ga.); Act of Apr. 29, 1786, (N.Y.). See respectively *Copyright Enactments*, *supra* note 37, at 11–13, 14–15, 18–20, 25–31.

41. See Act of Jan. 29, 1783 (Conn.); Act of Feb. 3, 1786, § 4 (Ga.); Act of Apr. 29, 1786, § 4 (N.Y.). See respectively *Copyright Enactments*, *supra* note 37, at 11–13, 27–31.

Connecticut’s savings clause read: “nothing in this act shall extend to affect, prejudice or confirm the rights which any person may have to the printing or publishing of any book, pamphlet, map or chart, at common law, in cases not mentioned in this act.” *Id.* at 13.

B. The Constitutional Convention and Ratification Debates

At the Constitutional Convention of 1787, both James Madison of Virginia and Charles Pinckney of South Carolina submitted proposals to give Congress the power to grant federal copyrights. Madison's proposal read: "To secure to literary authors their copy rights for a limited time."⁴² Pinckney's proposal read: "To secure to Authors exclusive rights for a certain time."⁴³ Pinckney also proposed that Congress be given the power "to grant patents for useful inventions."⁴⁴ These proposals were referred to the Committee on Detail. Later, provisions which had not been acted upon were referred to the Committee of Eleven (of which Madison was a member),⁴⁵ which drafted the

42. James Madison, *Notes of Debates in the Federal Convention of 1787*, at 477 (1966) (Aug. 18, 1787).

43. *Id.* at 478.

44. *Id.* In the manuscript version of his notes, Madison wrote that he had made a similar proposal, "to secure to the inventors of useful machines and implements the benefits thereof for a limited time"; but when Madison edited his notes for publication, he pasted over the manuscript with an edited version that did not contain this proposal. See Edward C. Walterscheid, *To Promote the Progress of Useful Arts: American Patent Law and Administration, 1798-1836*, at 46-47 (1998). Recent scholarship suggests that Madison's original notes are more reliable. See Dotan Oliar, *The (Constitutional) Convention on IP: A New Reading*, 57 *UCLA L. Rev.* 421, 435-46 (2009).

45. Madison, *supra* note 42, at 569 (Aug. 31, 1787).

Patent and Copyright Clause as it exists today, and recommended its adoption.⁴⁶ The clause was unanimously approved by the delegates with no debate reported.⁴⁷ It reads: “The Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const. art. 1, § 8, cl. 8.

The language of the Clause is ambiguous when it speaks of “securing” exclusive rights. For the next 47 years, the meaning of this term would be debated, with proponents of the natural-right view arguing that “securing” meant the affirmation of preexisting common-law rights, and proponents of the utilitarian view arguing that “securing” meant nothing more than “to obtain” or “to provide.”⁴⁸

In the subsequent ratification debates, the Clause was rarely mentioned. The most significant reference came in *The Federalist* No. 43, authored by James Madison:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged,

46. *Id.* at 580 (Sept. 5, 1787).

47. *Id.* at 581 (Sept. 5, 1787).

48. Edward C. Walterscheid, *Understanding the Copyright Act of 1790: The Issue of Common-Law Copyright in America and the Modern Interpretation of the Copyright Power*, 53 J. Copyr. Soc’y USA 313, 324–32 (2006).

in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.⁴⁹

In stating that copyright was a common-law right, Madison was simply echoing the conventional wisdom concerning the holding in *Donaldson*, as reported in both Burrow's report, see *supra* pp. 14–15, and in Blackstone's *Commentaries*.⁵⁰

49. *The Federalist No. 43*, at 267 (James Madison) (Henry Cabot Lodge ed., 1888).

50. The pertinent fourth volume of Burrow's reports was published in 1776, and citations to it are found in early Pennsylvania cases. See, e.g., *Respublica v. Doan*, 1 U.S. (1 Dall.) 86, 90–91 (Pa. 1784); *Nathan v. Virginia*, 1 U.S. (1 Dall.) 77, 78 (Pa. C.P. 1781).

The seventh edition of Blackstone reported that “it was determined in the case of *Millar v. Taylor* . . . that an exclusive copyright in authors subsisted by the common law. But afterwards, in the case of *Donaldson v. Becket*, . . . it was held that no copyright subsists in authors, after the expiration of the several terms created by the statute of queen Anne.” 2 William Blackstone, *Commentaries on the Laws of England* 407 n.h (Oxford, Clarendon Press 7th ed. 1775). Moreover, the first American edition of

Noah Webster, then editor of *American Magazine*, similarly affirmed the conventional wisdom:

The rights of literary property have not yet been clearly ascertained and established in this country. . . . Most of the states however have passed laws, securing to authors their literary productions for a limited time; and in those which have not, persons concerned will please to observe that, by a solemn adjudication in the courts of Westminster, it is determined that an action will lie at *common law* for publishing books . . . without the consent of the author or proprietor. This principle which is founded on common justice, will undoubtedly be admitted into American courts⁵¹

The stipulation in the Copyright Clause that patent and copyright protection be granted only “for limited Times,” and only to “authors” and “inventors,” appears to have been aimed at preventing the kinds of abuses (granting

Blackstone reported only the decision in *Millar v. Taylor*, affirming the common-law right, and not the subsequent decision in *Donaldson*. 2 William Blackstone, *Commentaries on the Laws of England* 407 (Philadelphia, Robert Bell 1771).

51. Acknowledgements, *American Magazine* 130 (Feb. 1788) (emphasis in original).

monopolies on existing trades) that had prompted the Statute of Monopolies 150 years earlier.⁵² There are additional reasons to believe that the Clause was intended to limit Congress' power. First, both Madison's and Pinckney's proposals were stated in plenary fashion; but the Committee of Eleven qualified them with the language of the preamble, "to promote the Progress of science and useful Arts."⁵³ Second, at the Convention both Madison and Pinckney were aligned with the nationalists who promoted a strong central government. The fact that their proposals were amended "by a body that was less centralist and more suspicious of the national government than Madison and Pinckney tends to suggest that the change was intended as a limitation on power."⁵⁴

Thus, the Clause appears to have been designed not so much to prescribe a means by which Congress could promote the progress of science and useful arts, but rather to limit the duration and

52. Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 49 J. Copyr. Soc'y USA 675, 691–94 (2002).

53. Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress's Intellectual Property Power*, 94 Geo. L.J. 1771, 1810–11 (2006). This language appears to have originated in other proposals by Madison and Pinckney that were rejected by the Committee. *Id.* at 1805–10.

54. *Id.* at 1814.

purposes for which exclusive rights could be granted.

C. The Copyright Act of 1790

Congress first exercised its new power in 1790. The Copyright Act of 1790 offered copyright protection to domestic authors only, for “any map, chart, book or books already printed within these United States,” for the term of 21 years, and for “any map, chart, book or books already made and composed, but not printed or published, or that shall hereafter be made and composed,” for the term of 14 years, renewable once; but only upon compliance with conditions, including registration of the title of the work with the clerk of the local district court before publication, and publication of notice in a newspaper. See Act of May 31, 1790, 1 Stat. 124, ch. 15, § 1. Except for the addition of maps and charts, the language of the 1790 Act was copied almost verbatim from the Statute of Anne.⁵⁵ See *Fred Fisher Music Co.*, 318 U.S. at 650.

Whether members of the First Congress believed that they were removing previously published works from the public domain cannot be resolved definitively, both because different members of Congress likely had different views on the subject, and because of a dearth of conclusive evidence. Nevertheless, given the evidence that is available to us, it is likely that a majority of the First Congress did *not* believe that they were removing

55. Bracha, *supra* note 39, at 1452–58.

works from the public domain. Instead, the likely purpose in enacting the 1790 Act was the same as the Statute of Anne: to limit rights that previously had been regarded as perpetual.

As noted above, there is significant circumstantial evidence that many of the Framers believed that a post-publication copyright was a right that was recognized at common law. First, the only mention of the Copyright Clause in *The Federalist* states flatly that “[t]he copy right of authors has been solemnly adjudged in Great Britain to be a right at Common Law.” See *supra* p. 20. Second, the preambles of seven of the state copyright laws expressly refer to copyright as a natural right, and three of those laws contained a savings clause specifically referring to common-law copyright. See *supra* p. 18. Third, the 1790 Act offers “the sole right and liberty of printing, reprinting, publishing, and vending” to the authors of books “already printed within these United States . . . who hath or have not transferred to any other person the copyright of such,” and to “any other person or persons . . . who hath or have purchased or legally acquired the copyright of any such” books. See Act of May 31, 1790, 1 Stat. 124, ch. 15, § 1. This language seems to implicitly recognize that an assignable common-law copyright already existed in previously published works.⁵⁶ Fourth, the conventional wisdom, both in England

56. Walterscheid, *supra* note 48, at 332–40.

and America, was that the majority of the advisory judges in *Donaldson v. Becket* believed there was a common-law right of literary property that survived publication, but that the common-law right had been superseded in England by the Statute of Anne. See *supra* pp. 14–15 and 20. Since the Statute of Anne did not apply in the colonies, the common-law right may very well have been deemed still to exist here, unpreempted, before 1790.

Evidence that *Donaldson* was viewed in the states as recognizing and preempting, rather than rejecting, common-law rights can also be found in Edward Christian's *Notes to Blackstone's Commentaries*, first published in Boston in 1801, in which he wrote:

Whether the productions of the mind could communicate a right of property or of exclusive enjoyment in reason and nature; and if such a moral right existed, whether it was recognized and supported by the common law of England; and whether the common law was intended to be restrained by the statute of queen Anne, are questions, upon which the learning and talents of the highest legal characters in this kingdom have been powerfully and zealously exerted.

These questions were finally so determined that an author has no right at present beyond the limits fixed by the statute. But as that

determination was contrary to the opinion of lord Mansfield [in *Millar v. Taylor*], the learned Commentator [Blackstone], and several other judges, every person may still be permitted to indulge his own opinion upon the propriety of it, without incurring the imputation of arrogance. . . .

No less than eight [*sic*] of the twelve judges were of opinion that this was a right allowed and perpetuated by the common law of England; but six held, either that it did not exist [*sic*], or that the enjoyment of it was abridged by the statute of queen Anne, and that all remedy for the violation of it was taken away after the expiration of the terms specified in the act; and agreeable to that opinion was the final judgment of the lords.⁵⁷

Although much of this evidence is circumstantial, at the very least it tends to show that there was no consensus at the time of the 1790 Act that Congress believed that it was removing works from the public domain.

There is also empirical evidence that only an extremely small number of works registered under the 1790 Act were works that were previously

57. Edward Christian, *Notes to Blackstone's Commentaries*, Book II, 45–46 (1801).

published, and therefore supposedly resurrected from the public domain. The surviving registration records from 1790 through 1800 have been compiled and published by the Library of Congress.⁵⁸ According to one scholar, of the estimated 20,829 books published during this period, registration records for only 684 books survive;⁵⁹ and of those, only 12 had been published before the 1790 Copyright Act came into effect.⁶⁰ This represents only 1.74% of all registered works, and only .058% percent of all published works during this period.⁶¹ Furthermore, although surviving state copyright records before 1790 are extremely fragmentary,⁶² at least five of the 12

58. *Federal Copyright Records 1790–1800* (James Gilreath, ed., & Elizabeth Carter Wills, comp., 1987).

59. William J. Maher, *Copyright Term, Retrospective Extension, and the Copyright Act of 1790 in Historical Context*, 49 *J. Copyr. Soc’y USA* 1021, 1023–24 & n.8 (2002).

60. *Id.* at 1025–27. This figure does not include revised and/or expanded editions of previously published works, which were considered “new” works for purposes of registration. *Id.* While these figures are necessarily incomplete, as no registration records from either Connecticut or New Jersey survive, *id.* at 1024–25, statistical extrapolation suggests there were probably only about 5 additional works in this category, *id.* at 1025 n.10.

61. *Id.* at 1027.

62. There are fewer than 40 surviving state copyright registrations. See G. Thomas Tanselle, *Copyright Records and the Bibliographer*, 22 *Stud. Bibliography* 77, 83–85 (1969).

previously published works had been registered for copyright under state law,⁶³ and therefore could not have been in the public domain at the time the 1790 Act came into effect.

Thus, even if some members of the First Congress did not believe that a post-publication common-law copyright existed, it is doubtful that “that the 1790 Congress . . . was engaged in providing blanket copyright coverage for ‘old works.’”⁶⁴ Instead, just as the Statute of Anne had provided a period of 21 years for previously published works, to limit the term of copyrights that previously had been regarded as perpetual, the 1790 Act likely provided protection to previously published works in order to limit any claims of copyright based on the common law, and to ease the transition from the uncertain and largely ineffective protection provided under the state copyrights acts to a single federal copyright.

D. The Copyright Act of 1831

We find probable confirmation of this view in the fact that forty years later, when the 1831 Act was adopted, key members of Congress still believed that a perpetual common-law copyright had existed prior to the Statute of Anne and the 1790 Act.

In 1826, Noah Webster wrote to Daniel Webster, who represented Massachusetts in the House,

63. Maher, *supra* note 59, at 1027.

64. *Id.* at 1031.

seeking his assistance in making the statutory term perpetual:

I sincerely wish our legislature would come at once to the line of right and justice on this subject, and pass a new act, the preamble to which shall admit the principle that an author has, by common law, or natural justice, the sole and *permanent* right to make profit by his own labor, and that his heirs and assigns shall enjoy the right, unclogged with conditions.⁶⁵

Daniel Webster replied that he would forward the letter to the Judiciary Committee, but he added “I confess frankly that I see, or think I see, objections to make it perpetual. At the same time I am willing to extend it further than at present.”⁶⁶

In 1828, Noah Webster’s son-in-law, William W. Ellsworth, was elected to Congress and appointed to the Judiciary Committee. The Report prepared by Ellsworth for the Committee shows the influence of Webster’s views. It stated that:

In England, the right of an author to the exclusive and perpetual profits of his book was enjoyed, and never questioned, until it was decided in

65. Noah Webster, *Origin of the Copy-Right Laws in the United States*, in *A Collection of Papers on Political, Literary and Moral Subjects* 176 (1843).

66. *Id.* at 176–77.

Parliament, by a small vote . . . that the statute of Ann had abridged the common law right, which, it was conceded, had existed, instead of merely guarding and securing it by forfeitures for a limited time, as was obviously intended.⁶⁷

The Report also stated that “[y]our committee believe that the just claims of authors require from our legislation a protection not less than what is proposed in the bill reported. Upon the first principles of proprietorship in property, an author has an exclusive and perpetual right, in preference to any other, to the fruits of his labor.”⁶⁸ Similarly, Representative Gulian C. Verplanck of New York, speaking in favor of the bill during the debate, stated:

[T]he work of an author was the result of his own labor. It was a right of property existing before the law of copyrights had been made. That statute did not give the right, it only secured it; it provided a legal remedy for the infringement of the right, and that was the sum of it. It was, he repeated, merely a legal provision for the protection of a natural right. . . . It

67. 7 *Gales & Seton’s Register of Debates in Congress*, at Appendix cxix (1831).

68. *Id.* at cxix–cxx.

was so held in England; and in the great case of literary property, tried before the court of King's Bench, the judges were unanimously of opinion that an author had an inherent right of property in his works.⁶⁹

Although this statement contains some factual inaccuracies, it is clear from the tenor of the debate that in 1831, many members of Congress who spoke on the matter believed that copyright was a natural right of the author that was protected at common law, before it was modified by the Statute of Anne. They likely believed that the same concept had been received into the common law of the states.

This Court addressed the issue a few years later.

E. *Wheaton v. Peters*

In 1827, Richard Peters succeeded Henry Wheaton as the official reporter of decisions for the U.S. Supreme Court.⁷⁰ In 1829, Peters began to publish "Condensed Reports" of the cases that had been decided prior to his appointment.⁷¹ Wheaton and his publisher sued, alleging that Peters had copied Wheaton's Reports. The trial judge, sitting in equity, dismissed the complaint, ruling that

69. *Id.* at 424.

70. Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 Mich. L. Rev. 1291, 1351–58 (1985).

71. *Id.* at 1362–70.

Wheaton had failed to comply with the formalities of the copyright statute and that it was doubtful he held any independent common-law rights. *Wheaton v. Peters*, 29 F. Cas. 862 (CCED Pa. 1832).

On appeal in the U.S. Supreme Court, Elijah Paine, arguing for Wheaton and citing *Millar v. Taylor*, contended that “An author was entitled, at common law, to a perpetual property in the copy of his works, and in the profits of their publication.” *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 595–96 (1834). Representing Peters, Joseph Reed Ingersoll countered that in *Donaldson v. Becket*, “the existence of the statute deprived the author of any right of action which he may have had at the common law.” *Id.* at 629. In reply, Daniel Webster argued that “[t]he common law was carried to Pennsylvania on its settlement; and the statute of Anne did not change or affect it.” *Id.* at 652.

Justice McLean delivered the majority opinion, which began by noting that

the law appears to be well settled in England, that, since the statute of 8 Anne, the literary property of an author in his works can only be asserted under the statute.

Id. at 657.

Although no more than this was necessary to reject Wheaton’s common-law claim as preempted by the 1790 Act, the Court instead questioned the existence, *ab initio*, of a common-law copyright after publication:

[N]otwithstanding the opinion of a majority of the judges in the great case of *Millar v. Taylor* was in favour of the common law right before the statute, it is still considered, in England, as a question by no means free from doubt.

That an author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavours to realise a profit by its publication, cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.

Id. The Court then asked: “But, if the common law right of authors were shown to exist in England, does the same right exist, and to the same extent, in this country[?]” *Id.* at 658. It replied that “there can be no common law of the United States” because “[t]he common law could be made a part of our federal system, only by legislative adoption.” *Id.* The Court then inquired “whether the common law, as to copyrights, if any existed, was adopted in Pennsylvania.” *Id.* Again, it suggested the answer was “no”:

No such right at the common law had been recognized in England, when the colony of Penn was organized [circa

1682]. Long afterwards, literary property became a subject of controversy, but the question was involved in great doubt and perplexity; and a little more than a century ago, it was decided by the highest judicial court in England, that the right of authors could not be asserted at common law, but under the statute. . .

Can it be contended, that this common law right, so involved in doubt as to divide the most learned jurists of England, . . . was brought into the wilds of Pennsylvania by its first adventurers. Was it suited to their condition?

Id. at 660.

The Court further reasoned that because the Patent and Copyright Clause used the word “securing,” and because “it has never been pretended, by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented,” Congress must have been creating new rights rather than protecting preexisting rights. *Id.* at 661. Thus, it concluded that “if the right of the complainants can be sustained, it must be sustained under the acts of congress.” *Id.* at 662.

In rejecting any possibility that federal common law existed, and looking instead to state law, the

Court anticipated the landmark holding in *Erie Railroad Co. v. Tompkins*, 304 U.S. 64 (1938), over a century later. As the final authority on questions of federal law, the Court's holding in *Wheaton* that there was no federal post-publication common-law copyright is conclusive. But under *Erie*, not even the Supreme Court of the United States can have the final say concerning a matter of state law; that role belongs to the Supreme Court of Pennsylvania. Had the Supreme Court in *Wheaton* been aware of the body of English equity cases based on a common-law right that predated the Statute of Anne—many of which were contemporaneous with the founding of Pennsylvania, see *supra* pp. 7–11—it might have refrained from expounding on the common-law of Pennsylvania and confined itself to holding, as a matter of federal law, that whatever post-publication copyright may have existed at common law was preempted by the 1790 Act. Instead, *Wheaton*'s holding effectively precluded the further development of state law on the subject for more than a century.

There were indications in the 20th Century that the Supreme Court of Pennsylvania may have had a different view of what the common law provided some 150 years earlier. The one area of copyrightable subject matter that is not preempted by federal law, and will not be preempted until February 15, 2067, concerns sound recordings fixed before February 15, 1972. See 17 U.S.C. § 301(c); *Goldstein v. California*, 412 U.S. 546, 571 (1973). In upholding a common-law copyright in published

sound recordings in 1937, the Pennsylvania Supreme Court stated:

At common law, rights in a literary or artistic work were recognized on substantially the same basis as title to other property. Such rights antedated the original copyright act of 8 Anne c. 19, and, while it has been uniformly held that the rights given by the act supersede those of the common law so far as the act applies, the common-law rights in regard to any field of literary or artistic production which does not fall within the purview of the copyright statute are not affected thereby.

Waring v. WDAS Broadcasting Station, 327 Pa. 433, 439, 194 A. 631, 634 (1937). The court then acknowledged in a footnote:

It has long been a subject of discussion as to whether common-law rights in literary property survive publication, and whether, therefore, the copyright statute has restricted or broadened such rights. The early English view seems to have been that publication does not defeat the rights of proprietorship at common law. *Millar v. Taylor*, 4 Burr. 2303, 98 Eng. Rep. 201; *Donaldson v. Becket*, 4 Burr. 2408, 98 Eng. Rep. 257. The American view has been to the contrary, and

holds that the common-law right is confined to the first publication. *Wheaton v. Peters*, 8 Pet. (33 U.S.) 591; *Caliga v. Inter Ocean Newspaper Co.*, 215 U.S. 182

327 Pa. at 439 n.5, 194 A. at 634 n.5.

It is clear from this footnote and elsewhere that the Pennsylvania Supreme Court felt bound by *Wheaton*. Ultimately, the court found a way around *Wheaton* by holding that a reservation of rights (“Not Licensed for Radio Broadcast”) on phonograph records distributed to the public was sufficient to render the publication a “limited publication” that did not divest the plaintiff of its common-law rights. 327 Pa. at 447–48, 194 A. at 638. However, if *Waring* had been decided one year after *Erie*, instead of one year before, the state court might not have felt so constrained and might not have resorted to such a fiction.

Moreover, post-*Erie*, the highest court of at least one state, New York, has expressly questioned *Wheaton*’s “unpersuasive analysis of Pennsylvania common law,” *Capitol Records, Inc. v. Naxos of America, Inc.*, 4 N.Y.3d 540, 552 n.5, 830 N.E.3d 250, 258 n.5 (2005), and held that “[b]ecause the federal Copyright Act did not protect musical recordings, state common law could supply *perpetual* copyright protection to recordings without regard to the limitations of ‘publication’ under the federal act.” 4 N.Y.2d at 559, 830 N.E.2d at 263 (emphasis added).

The point of citing these modern decisions is not to try to demonstrate what judges in Pennsylvania may have thought about common-law copyright at the time of the founding. The point is that the debate rages on, and that we are no closer to definitively resolving the question of common-law copyright than we were in 1790.

In view of the unsettled nature of the question, the evidence that at least some of the Framers believed in the existence of a post-publication common-law right, and the lack of conclusive evidence to the contrary, we certainly cannot conclude that the Congress that drafted the 1790 Act rejected the notion of common-law copyright and believed that they were restoring copyrights in works that had previously been in the public domain.

CONCLUSION

For the foregoing reasons, this Court should conclude that there is no First Congress precedent for the URAA.

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